

REMARKS

Applicant has amended claims 1, 3, 4, 6, 8, 9 and 11, cancelled claims 12-17, and added new claims 18-26. No new matter is added. Applicant respectfully requests entry of the amended and newly added claims.

The Examiner rejected claims 1-17 under 35 U.S.C. Section 112, first paragraph, as failing to comply with the written description. Applicant respectfully traverses the rejection although claim 1 has been amended to read “the displayed icon being *independent* of a television program being displayed on the television screen” (emphasis added). The Examiner stated that the specification does not support the language of advertising icons being “un-associated with” the television programming.

To the contrary, there are many places in the specification that clearly suggest that the advertising icons being displayed are not associated with the television programs being shown. For example, the specification at page 9, lines 7-12 states that the displayed icons *change to new icons every 2 minutes*. If the icons are associated with the TV programming shown, the icons cannot change at fixed time intervals. Instead, the icons would need to change on-the-fly as the TV programming changes or as the user changes TV channels. Since neither is the case in the present invention, the displayed icons are unrelated to (or “independent of”) the TV program being shown.

Moreover, on page 9, lines 22-29, the specification states that the “associated *display icons 50* may be automatically downloaded 144 to the set top box 30 memory devices on a regular basis. For example, the information can be downloaded 144 *during the early morning of each day, or once per week or less frequently, . . .*”. In other words, the icons are downloaded independently of any TV programming being shown, but rather are downloaded on a fixed schedule in one embodiment. If the icons are associated with the TV programming shown as the Examiner suggests, the icons (and not just the related advertising information) must be downloaded *in real time as the TV programming changes*. Instead, in one embodiment of the invention, the icons are downloaded on a fixed schedule regardless of what TV programming is being shown. Accordingly, the recited language in claim 1 of “the displayed icon being *independent* of a television program being displayed on the television screen” is fully supported in the specification. For these reasons, Applicant respectfully

requests the Examiner to withdraw the Section 112, first paragraph, written description rejection.

The Examiner rejected claims 1-17 under 35 U.S.C. Section 103(a) as being obvious over Kitsukawa (US Patent No. 6282713) in view of Shoff (US Pub. No. 2001/0001160) and Schein (US Pub. No. 2003/0208758). Applicant respectfully traverses the rejection.

The Examiner concedes that Kitsukawa does not show that the icon and advertising information is un-associated with the television program. The Examiner then cites paragraphs 74-75 of Schein as teaching that the advertising icon is unassociated with the TV programming being shown. Applicant respectfully disagrees.

In the sections referred to by the Examiner, Schein is designed to work with a PCTV which is a "television coupled to a computer system" (see paragraph 72). By contrast, the present invention as claimed in claim 1 is designed to work with a set-top box only and not a computer attached to the set top box. For example, claim 1 recites "transmitting the icons . . . to the *set top box communications box*" and "detecting an input signal indicating that the displayed icon has been selected with an *input device for the set top communications box.*" The input device may be for example a remote control device for the set top box. Consequently, both the user interaction and Internet communication are all done by the set top communications box according to the invention of claim 1, and not by a separately attached computer as is the case with Schein. Thus, the combination of Kitsukawa and Schein still does not produce the invention claimed in claim 1.

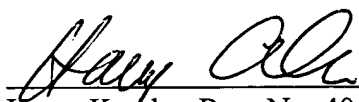
Claims 2-11 are also patentable by virtue of their dependency from independent claim 1.

Applicant has added new claims 18-22. Claims 18-22 recite that (1) both the advertising icons and the associated advertising information are downloaded from the Internet, and (2) the user interaction and Internet communication are done by the set top communication box itself. Applicant submits that none of the cited references, either individually or in combination, teach or suggest such a novel combination.

Claims 23-26 are drawn along similar lines. Applicant submits that those claims are novel and distinguishable over the cited references.

Based upon the above amendments and remarks, Applicant respectfully requests reconsideration of this application and its earlier allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,



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